



APV / IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Douglas D. DeMasi, Sr.
SN 09/845,999
Filed: 9/24/2001
For "Universal Flying Hawk"

: Art Unit 3714
: Examiner Miller, Bena B.

8 Scenic Drive; Hagan Farms
Poughkeepsie, NY 12603-5521

March 29, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop - Petition

PETITION

Sir:

In partial response to the FINAL Office Action mailed 1/9/07 and the Advisory Action mailed 3/12/07, applicant hereby petitions the Commissioner for Patents in the above-identified application (A) to set aside the action of 1/9/07 as FINAL; (B) to overrule the Examiner's refusal to enter, per the Advisory Action mailed 3/12/07, the amendments proposed in the Amendment After Final dated 2/17/07 and filed 2/20/07; (C) to overrule the Examiner's rejection under 35 USC 112, first paragraph, in the 1/9/07 Action that claims 21-33, 38-42 and 44-51 fail "to comply with the written description requirement"; and (D) to overrule the Examiner's rejection under 35 USC 112, first paragraph, in the 1/9/07 Action that claims 21-33, 38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention".

The Amendment After Final dated February 17, 2007 and filed February 20, 2007, stands not entered because the Examiner in the Advisory Action mailed 3/12/07 held that the proposed amendments (a) "raise new issues that would require further consideration and/or search", and (b) raise the issue of new matter".

In the Amendment After Final dated February 17, 2007 and filed 2/20/07, applicant proposed to edit the Specification in the second paragraph under the section SUMMARY OF THE INVENTION to read:

"A more specific object of the invention is to provide a recreational product that can be towed by a power boat on the water, and can thereafter gotten airborne and kept airborne, that is, deriving its lift in flight from forces resulting from its motion through air, with complete control by the rider."

Applicant had proposed the refinement because the Examiner had rejected claims 21-33, 38-42 and 44-51 under 35 USC 112, second paragraph, for having amended claims 21, 28, 38 and 44 by adding the words "DERIVING ITS LIFT IN FLIGHT FROM FORCES RESULTING FROM ITS MOTION THROUGH AIR" via an Amendment dated October 16, 2006 and filed October 18, 2006 (post card receipt). Applicant had added the words to the claims to distinguish his invention over the newly cited of Goudy (3,650,234) or Skaszynski (1,099,575) or Schlueter (3,320,625). Applicant had amended claim 21 to specify that the rider recreational product for flying through the air do so "aerodynamically", and further that the "first section constituting the wing of the product" derive "its lift in flight from forces resulting from its motion through air".

Petitioner urges that the meaning of the phrase "deriving its lift in flight from forces resulting from its motion through air" is inherent in the phrase "kept airborne", and thus does not constitute new matter. The meaning is also consistent with the rest of the specification and with the drawings and definitions in dictionaries..

Petitioner requests the Commissioner:

- (A) to set aside the action of 1/9/07 as FINAL;
- (B) to overrule the Examiner's refusal to enter the amendments proposed in the Amendment After Final;
- (C) to overrule the Examiner's rejection under 35 USC 112, first paragraph, that claims 21-33, 38-42 and 44-51 fail "to comply with the written description requirement"; and

(D) to overrule the Examiner's rejection under 35 USC 112, first paragraph, that claims 21-33,38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention".

Applicant submits:

1) that no issue of new matter is involved: all of the matter covered by the proposed claims has been present in the application since it was filed;

2) that no new search should be required, either. MPEP Section 707.07(g) ordains that "Piecemeal examination should be avoided as much as possible." Moreover, MPEP Section 904.02 specifies that "In the examination of an application for patent, an examiner must conduct a thorough search of the prior art."; and that "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed.";

3) that the subject matter of the proposed amendments were disclosed features which might reasonably be expected to be claimed. Thus they should already have been searched for, and no new search should be required.

4) that there being no new subject matter, and no need for a new search, the amendments proposed should be entered.";

5) that applicant is entitled to have the amendments proposed entered, to have the amended claims examined and found allowable since they distinguish patentably over the cited art, and to have the application allowed; and

6) that the Final Rejection should be withdrawn as no clear issue had been reached and was otherwise premature.

ARGUMENT

A. Making the action of 1/9/07 as FINAL was not correct, and should be set aside.

Making the action of 1/09/07 FINAL was premature. While it is true that the application had been twice rejected, it is also true that applicant was making an earnest effort to place the application in condition for allowance by amending the claims to distinguish over the cited art. Furthermore, a final rejection on an action can be premature when a clear issue has not been reached. Ex parte Ulfstedt and Bengtsson, 109 USPQ 458; P.O. Sup. Ex. (1956). A clear issue has not been reached when different references are relied upon in successive actions.

Moreover, at least one, Saghri (5,498,184), of the new references cited by the Examiner, was not necessitated by any amendment to the claims. The "inflatable bladder" called for by claims 33 and 37, was previously present in the claims.

B. The refusal to enter the Amendment After Final dated 2/17/07 and filed 2/20/07 was not correct!

The Amendment After Final dated 2/17/07 and filed 2/20/07, stands not entered because the Examiner in the Advisory Action mailed 3/12/07 held that the proposed amendments (a) "raise new issues that would require further consideration and/or search"; (b) "raise the issue of new matter"; and "raise new issues that would require further consideration and/or search and raise the issue of new matter".

Applicant urges:

- 1) that no issue of new matter is involved: all of the matter covered by the proposed claims has been present in the application since it was filed;**

- 2) that no new search should be required, either. MPEP Section 707.07(g) ordains that "Piecemeal examination should be avoided as much as possible." Moreover, MPEP Section 904.02 specifies that "In the examination of an application for patent, an examiner must conduct a thorough search of the prior art."; and that "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed."
- 3) that the subject matter of the proposed amendments were disclosed features which might reasonably be expected to be claimed. Thus they should already have been searched for, and no new search should be required.
- 4) that there being no new subject matter, and no need for a new search, the amendments proposed should be entered; and
- 5) that applicant is entitled to have the amendments proposed entered, to have the amended claims examined and found allowable since they distinguish patentably over the cited art, and to have the application allowed."

Thus applicant believes that, if the Commissioner deems any of the claims not to be allowable in their present state, the Examiner should be instructed to enter the proffered amendments for them.

- (C) The Examiner's rejection under 35 USC 112, first paragraph, that claims 21-33, 38-42 and 44-51 fail "to comply with the written description requirement"; should be overruled.

The Examiner alleged, in the FINAL action of 1/9/07, that the "claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 21, 28, 38 and 44, the subject matter, 'deriving its lift in flight from forces resulting from its

motion through air', as now amended, is not supported by the original specification and therefore, now constitute New Matter."

As observed above, applicant's Specification had read: "A more specific object of the invention is to provide a recreational product that can be towed by a power boat on the water, and can thereafter gotten airborne and kept airborne with complete control by the rider." Applicant urges that the words "deriving its lift in flight from forces resulting from its motion through air" is completely synonymous with "kept airborne" in the phraseology involved, and should not be considered new matter. The words are also consistent with the rest of the Specification and the drawings.

(D) The Examiner's rejection under 35 USC 112, first paragraph, that claims 21-33,38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention", should be overruled.

The Examiner alleged, in the FINAL action of 1/9/07, that the "claims are replete with indefiniteness that is too numerous to point out in every instance. The following examples are provided for the applicant use in making correction wherever appropriate but not specifically pointed to.

Regarding claims 21, 28, 38, and 44, it is not clear whether the product derives its lift in flight from forces resulting from its motion through air."

As noted above, the Specification contains the phrase "kept airborne" which applicant urges is synonymous with the phrase "derives its lift in flight from forces resulting from its motion through air." One purpose of the proffered Amendment After Final was to make that very clear.

As to the Examiner's further examples of "indefiniteness", applicant addressed them as follows in the Amendment After Final dated February 17, 2007 and filed

February 20, 2007, and believes the comments warrant entry, at least in part, of the Amendment:

Regarding claim 28, the Examiner observed that "it is not clear whether the fins act as a ski when the thin fins extends upwardly from a surface of the wider rear end and acts as a surfboard when the thin fins extends longitudinally from a surface of the wider rear end." As set forth in claim 28 of the Amendment dated October 16, 2006 and filed October 18, 2006 (postcard receipt): "and thin fins extending upwardly when used as a ski and downwardly when used as a surfboard and longitudinally"

The Examiner also observed: "Further, it appears that 'that are upwardly when the board is attached'" is a method step and it is not clear how the phrase further structurally define the claimed apparatus'. Applicant urges that the limitation requires that the fins must extend upwardly when the board is attached. This is a functional and structural statement, and believed proper.

Regarding claims 29-32 , the Examiner observed that "it is not clear how the limitation 'when the board is attached' further structurally limit the claim". Applicant urges that the claims further structurally limit the claims by requiring that "the surface that is upwardly when the board is attached to the recreational product", "has control elements on its upper surface for engagement by the rider'.

Regarding claim 34, the Examiner observed that "the phrase 'for receiving an attachment rendering the body the wing of a recreational vehicle' is confusing". Applicant apologizes for any confusion but believes the phraseology does say that that the body is rendered "the wing of a recreational vehicle" when the body "central rearward portion" receives an attachment. If the Examiner strongly feels about the matter, applicant is amenable to an Examiner's Amendment to the same effect.

Regarding claim 41, the Examiner observed that "it is not clear how the central longitudinal fin is connected". Claim 38 specifies inter alia: "the first section having

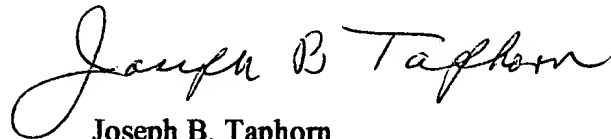
longitudinally-extending control fins on its underside for withstanding rugged or slow turns in water and air". Claim 41 merely locates one longitudinal fin. It is connected to the underside of the first section.

SUMMARY

Appellant urges that at best the final rejection was premature. The amendments proffered by the Amendment After Final should be ordered entered. The actions of the Examiner should be reversed.

A Notice of Appeal is being filed concurrently herewith.

Respectfully submitted,



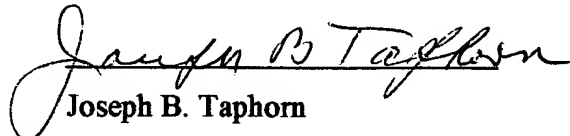
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CERTIFICATE OF MAILING - The undersigned certifies that this correspondence addressed to the Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop - Petition; has been deposited in the United States Postal System as first class mail with sufficient postage on March 30, 2007.



Joseph B. Taphorn